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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,951	01/15/2002	William Kress Bodin	AUS920010850US1	4423

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EXAMINER

FLEARY, CAROLYN FATIMAH

ART UNIT PAPER NUMBER

2152

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/046,951

Applicant(s)

BODIN ET AL.

Examiner

Carolyn F. Fleary

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/27/05.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1,4,6,9,11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US 6,311,210) in view of Moran et al. (US 2003/0104827) in view of Segur (US 6,212,550).**

In regards to claim 1, 4, 6, 9, 11 and 14 Foladare et al. discloses a method and system for email administration comprising steps:

- Receiving (via means-200, col. 4 l. 35-37, recorded on a medium as described in col. 7 l. 28-41) through a transcoding gateway (160) an email message (col. 3 ll. 15-16), wherein
- the email message comprises at least one digital object (e.g. attachment, files, bitmap, documents etc, col. 6 ll. 23-26 )
- the transcoding gateway(160) is coupled to one or more display devices (302, 120-150), and
- transcoding gateway comprises, for each display, a display device record (fig. 3 ) comprising display format attributes (303,file extensions, col. 5 ll. 11-15, col. 6 ll. 37-40 ) of each display device(302, 120-150 ), wherein the display format attributes(303,file extensions, col. 5 ll. 11-15, col. 6 ll. 37-40 ) include a display

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format type for each display device (e.g. display format type equates to file extensions such as .doc. exe .bmp etc. )

- finding a display device (by way of means on a recorded medium-200&160 col. 7 l. 28-41 ) record for a destination display device ( e.g. destination display device is a recipient of email message with an attachment ), wherein the destination display device comprises a display having a display format type (e.g. display format type equates to file extensions such as .doc. exe .bmp etc. ) that is the same as the digital object type (e.g. e.g. attachment, files, bitmap, documents etc, which have same file extensions such as .doc , .exe. bmp etc, col. 6 ll. 21-40)
- displaying the digital object on the destination display device (col. 6 ll. 55-57)

Foladare et al. is silent on:

- transcoding the digital object in dependence upon the display format attributes of the destination display device.
- the displayed digital object is an transcoded digital object.

*Moran et al. discloses a method of email administration where transcoding email message based on display format attributes as shown below*

- receiving through a transcoding gateway (70 ) an email message (75), the transcoding gateway (70) is coupled ton one or more display devices (38,48,87,89,91,93), the transcoding gateway (70) comprises, for each display device (38,48,87,89,91,93), a display device record (80,82,81,84-94 [0029]) comprising display format attributes of each device (90 e.g. capability information [0029-0030],[0037]), finding a display device record for a destination display device ([0030][0037])

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- transcoding (via means disclosed in [0030] on recording medium discloses in [0060-0063]) the email message in dependence upon the display format attributes (e.g. device capabilities) of the destination display device ( [0030][0038] ); and
- displaying the transcoded email message (e.g. destination message) on the destination display device ( [0038])

Moran et al. is silent on

- wherein said email message comprises at least a digital object having a digital object type.

*However Segur discloses a method of email administration where email messages, like those of Moran et al. comprise digital objects (e.g. voice mail and video mail which are actually email messages with attached/embedded digital objects.) as shown below*

- receiving through a transcoding gateway (10) an email message (16,12,14 all electronically sent mail messages including email video mail and voice mail),
- wherein the email message (16,12,14 all electronically sent mail messages including email, as well as video mail and voice mail) comprises at least one digital object (e.g. In the case of email messages video and voice mail, a digital object is a voice and video component transmitted with the message respectively)having a digital object type( e.g. types include voice, video, text etc associated with the message).

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Moran et al. by Segur in order to translate a message (e.g. which includes voice video, text objects) in a format required by a user (col. 4 ll. 10-20) and further it would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. by *transcoding email message based on display format attributes taught* by Moran et al. in view of Segur in order to allow users to send message from their devices to other

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service provider devices that contain different attributes than the sending device ( abs, col. [0008][030]).

In regards to claim 4,9 and 14, Foladare et al. in view of Moran et al. in view of Segur discloses wherein displaying the transcoded digital object on the destination display device further comprises writing the transcoded digital object to display memory(Foladare et al. - 203, col. 3 l. 34-40, col. 4 l. 22-26)

**3. Claims 2,3,5,7,8,10,12,13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US 6,311,210) in view of Moran et al. (US 2003/0104827) in view of Segur (US 6,212,550) as applied to claim 1 above, and further in view of Tsai (US 6,839,741).**

In regards to claim 2,3,5, 7,8,10,12,13, and 15 discloses wherein the transcoding gateway comprises an email client (105,160,110,115,125,135, 120,130,143,150 all of which receive and email sent by a user -100) and a service provider (115,125,135)

Foladare et al. is silent on wherein the service provider in the transcoding gateway is an HTTP Server and wherein the transcoding gateway further includes a web browser.

Moran et al. in view of Segur discloses wherein the transcoding gateway further includes a HTTP server (76, [0035]))

Moran et al. in view of Segur are silent on wherein the transcoding gateway further includes a web browser

Tsai discloses a transcoding gateway ( e.g. system comprising of 112,108,106,84, 86) wherein the Transcoding gateway also comprises an email client,(86, 108, col.7 l. 5-8 ) a web browser(84), and a HTTP Server(106).

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It would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. in view of Moran et al. in view of Segur by having a transcoding gateway which comprises an email client, web browser and HTTP Server, as taught by TSAI in order to facilitate the presentation of email attachments on local email clients and web-based email clients received by a recipient (col. 2 ll. 1 ll. 6-9, col. 2 ll. 7-13).

In regards to claim 3, 8 and 13 Foladare et al. in view of Moran et al. in view of Segur discloses a client device) comprises a display device and microcomputer (Foladare et al. - client device comprised of {160,110,115,125,135,120,130,140,150}), Moran et al. client device further comprises {all components in fig 3A except server-83} Segur (fig 1-3); all act clients to user that serves the email)

Foladare et al. in view of Moran et al. in view of Segur are silent on wherein the microcomputer further comprises the transcoding gateway, Email client, Web browser, HTTP server, wherein the transcoding gateway, the email client, the web browser and the HTTP server (20/90, col. 49-50) are coupled for data communications.

Tsai discloses further discloses a client device comprises a display device (110- which stores attachment; web server -20 which stores attachment col. 4 ll. 61-64), wherein the microcomputer further comprises the Transcoding gateway (90), Email client (84) Web browser(86) HTTP server (20/90, col. 49-50) wherein the transcoding gateway(112), the email client (84), the web browser (86) and the HTTP server (20/90, col. 49-50) are coupled (e.g. Tsai shows coupling via an LAN-91 among a email client, web browser and HTTP server) for data communications.

It would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. in view of Moran et al. in view of Segur by Tsai for the same reasons as disclosed within the rejection of claim 2 above.

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In regards to claim 5,10 and 15, Foladare et al. in view of Moran et al. in view of Segur discloses displaying the transcoded digital object.

Foladare et al. in view of Moran et al. in view of Segur are silent on:

- wherein displaying the transcoded digital object on the destination display device further comprises sending the transcoded digital object to a browser.

Tsai discloses

- wherein displaying the transcoded digital object (col. 6 ll. 53-57) on the destination display device (fig 5-14A-C) further comprises sending the transcoded digital object (fig 5. #26) to a browser (fig 4-84, col. 5 ll. 25-30,38-42).
- It would be obvious to one of ordinary skill in the art at the time of the invention to modify Foladare et al. in view of Moran et al. in view of Segur by Tsai for the same reasons as disclosed within the rejection of claim 2 above.

#### *Response to Arguments*

4. Applicant's arguments, filed 06/27/2005, with respect to the rejection(s) of claim(s) 1,4, 6, 11 and 14 under 35 USC 102 over Shaffer (US 6,092,114). have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Foladare et al. (US 6,311,210) in view of Moran et al. (US 2003/0104827) in view of Segur (US 6,212,550) as disclosed above.

**5. In response to Applicants argument, Tsai does not disclose a transcoding gateway, and display device records, Examiner respectfully, disagrees.**

Tsai discloses a system which transcodes a digital object (e.g. attachment) such that the digital object (e.g. attachment) is based on display device attributes (HTML attributes for HTML based destination devices). The invention as claimed does not provide an indication that each display device record must contain different/varying/contrasting display device attributes and as such Tsai system sends digital objects to display devices which happened to all have the same display device attributes. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case applicants argument is considered moot in light of new combination of Foladare et al. in view of Moran et al. in view of Segur further in view of Tsai above.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Prior art not made of record and not relied upon as disclosed in Office action dated March 24, 2005 is incorporated herein, in addition to new prior art not relied upon recorded in attached US-PTO 892 Notice of References Cited. Examiner respectfully recommends Applicant review all prior art considered pertinent to applicant's disclosure.

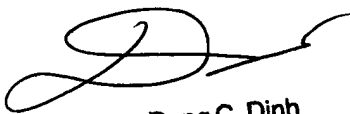
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn F. Fleary whose telephone number is (571) 572-7212. The examiner can normally be reached on 8:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn F Fleary  
Examiner  
Art Unit 2152

CFF



Dung C. Dinh  
Primary Examiner